REMARKS

The claims under final rejection are 6, 8 and 11 to 13, the remaining claims being withdrawn as the result of a restriction and election of species requirements.

The claims were rejected under 35 USC § 103(a) over Matsuda et al. (US 4,008,196) and over Kim et al. (US 4,180,491).

Applicants respectfully request reconsideration of the examiner's Final Rejection of 6 Jun 03. The references have been discussed in detail by the examiner (albeit applicants respectfully disagree as to their probative value vis-à-vis §103(a)) and in applicants' prior amendments, and therefor need no further detailed discussion here.

The examiner's arguments are primarily bottomed on the holding in *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985) that *under the facts of that* case, a *particular* method was obvious merely because the starting material and the end product were patentable in and of themselves. However, as discussed in great detail in MPEP § 1226.01 (Rev.1, Feb. 2003), *Durden* did not propound a *per se* rule; the question is a fact intensive one where no claim limitations can be ignored. Indeed, the facts in the present application are more closely aligned with those in *In re Pleuddemann*, 910 F.2d 823, 15 USPQ2d 1738 (Fed.Cir. 1990) (discussed in the MPEP, ibid) which held that methods of bonding polymer and filler using a novel silane coupling agent was held patentable even though methods of bonding using other silane coupling agents were well known because the process could not be conducted without the new agent. *In re Kuehl,* 475 F.2d 658, 177 USPQ 250 (CCPA 1973) (Also

discussed in the MPEP) is another case closely aligned with the facts here.

In the instant application, the invention is part and parcel of the *invention as a whole;* it is compounds (1) which breathe life and meaning into the claimed method for treating a compound or surface.

The *raison d'être* of applicants' invention is the use of compounds (1) as "building blocks which make it possible to functionalize or modify compounds or surfaces having isocyanate-reactive groups in any desired way" (Specification, page 2 lines 15 to 24; see also page 8 lines 37-38). In other words, this invention provides for the ability to modify surfaces made to order.

Moreover, the claims now make it more clear that the compounds (1) of the invention are used as mono-functional reactants -- i.e., "which group reacts with the with the OCN-R^1- moiety of the formula (1) wherein Y is retained as a hydrogen or a free functional group" -- regardless of the definition of "Y". If Y should happen to be an isocyanate, the final product, after the mono-functional reaction of the claims would retain that isocyanate.

Neither of the references reasonably would have conveyed this concept *at the time the invention was made,* and certainly would have not suggested the method covered by the claims utilizing applicants' compound (1). It is only by hindsight, utilizing applicants claims as the blueprint, could applicants invention be found in the prior art, if at all. Thus the references do not make out the necessary prima facie case for obviousness.

To the extent the examiner may be relying on "inherency", "the fact that a certain

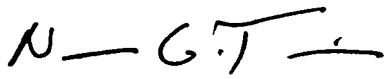
result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)." MPEP § 2112 .

Accordingly allowance is respectfully solicited. However, should the examiner disagree, it is requested that the amendment be entered to place this application in better condition for appeal.

Should a fee be required, kindly charge Deposit Account No. 11-0345.

Respectfully submitted,

KEIL & WEINKAUF



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